



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,268	02/06/2004	Alicia Roso	0503-1118-	8673
466 7590 06/04/2007 YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER GEORGE, KONATA M	
			ART UNIT	PAPER NUMBER
			1616	
			MAIL DATE	DELIVERY MODE
			06/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/774,268	Applicant(s) ROSO ET AL.	
	Examiner Konata M. George	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41 is/are allowed.
- 6) ☒ Claim(s) 12-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 12-41 are pending in this application.

Action Summary

1. The rejection of claim 14 under 35 U.S.C. 112, second paragraph for being indefinite is hereby withdrawn in view of applicants' arguments.
2. **The rejection of claims 12-24 and 26-40 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 6, 10-16, 22 and 23 of U.S. Patent No. 6,197,287 is being maintained for the reasons stated in the office action dated September 5, 2007.**

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 12-24 and 26-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 6, 10-16, 22 and 23 of U.S. Patent No. 6,197,287. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the patent are directed towards a composition comprising a "self-invertible inverse latex" as defined above (see Nature of Invention). The difference between the two lies in that the instant application requires an additional component (powder) whereas; the composition of the patent does not. The composition of the patent is not limited to what is claimed as the language "comprising" is used. One of ordinary skill in the art would be motivated to incorporate a powder into the composition for the purposes of providing texture to the final product i.e. soap, which may be used as a skin exfoliate.

Response to Arguments

4. Applicant's arguments filed March 5, 2007 have been fully considered but they are not persuasive.

Applicants argue that the composition of '287 does not teach 10-99% of a powder component. As stated in the office action the claim language is open and not limited to only what is claimed. The addition of a powder to a cosmetic composition is well known in the cosmetic art. When formulating a texturizing composition, the amount of powder added would determine how much texture the composition will have. A large

amount of powder produces a composition with a lot of texture, whereas a small amount of powder produces a composition with little texture. Furthermore, in review of the specification applicants teach the use of a powder under the name of Micropearl™ in several examples.

5. The rejection of claims 12-24 and 26-40 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 15, 18, 20 and 22-24 of U.S. Patent No. 6,673,861 is being maintained for the reasons stated in the office action dated September 5, 2007.

6. Claims 12-24 and 26-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 15, 18, 20 and 22-24 of U.S. Patent No. 6,673,861. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the patent are directed towards a composition comprising a "self-invertible inverse latex" as defined above (see Nature of Invention). The difference between the two lies in that the instant application requires an additional component (powder) whereas; the composition of the patent does not. The composition of the patent is not limited to what is claimed as the language "comprising" is used. One of ordinary skill in the art would be motivated to incorporate a powder into the composition for the purposes of providing texture to the final product i.e. soap, which may be used as a skin exfoliate.

Response to Arguments

7. Applicant's arguments filed March 5, 2007 have been fully considered but they are not persuasive.

Applicants argue that the composition of '861 does not teach 10-99% of a powder component. As stated in the office action the claim language is open and not limited to only what is claimed. The addition of a powder to a cosmetic composition is well known in the cosmetic art. When formulating a texturizing composition, the amount of powder added would determine how much texture the composition will have. A large amount of powder produces a composition with a lot of texture, whereas a small amount of powder produces a composition with little texture. Furthermore, in review of the specification applicants teach the use of a powder under the name of Micropearl™ in several examples.

8. The rejection of claims 12-24 and 26-40 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 15, 18, 20 and 22-24 of U.S. Patent No. 7,033,600 is being maintained for the reasons stated in the office action dated September 5, 2007.

9. Claims 12-24 and 26-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 15, 18, 20 and 22-24 of U.S. Patent No. 7,033,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the

patent are directed towards a composition comprising a "self-invertible inverse latex" as defined above (see Nature of Invention). The difference between the two lies in that the instant application requires an additional component (powder) whereas; the composition of the patent does not. The composition of the patent is not limited to what is claimed as the language "comprising" is used. One of ordinary skill in the art would be motivated to incorporate a powder into the composition for the purposes of providing texture to the final product i.e. soap, which may be used as a skin exfoliate.

Response to Arguments

10. Applicant's arguments filed March 5, 2007 have been fully considered but they are not persuasive.

Applicants argue that the composition of '600 does not teach 10-99% of a powder component. As stated in the office action the claim language is open and not limited to only what is claimed. The addition of a powder to a cosmetic composition is well known in the cosmetic art. When formulating a texturizing composition, the amount of powder added would determine how much texture the composition will have. A large amount of powder produces a composition with a lot of texture, whereas a small amount of powder produces a composition with little texture. Furthermore, in review of the specification applicants teach the use of a powder under the name of Micropearl™ in several examples.

11. The provisional rejection of claims 12-24 and 26-40 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 29-31 of copending application 09/888,441 is being maintained for the reasons stated in the office action dated September 5, 2007.

12. Claims 12-24, 26-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 29-31 of copending Application No. 09/888,441. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed towards a composition comprising a "self-invertible inverse latex" as defined above (see Nature of Invention). The difference between the two lies in that the instant application requires an additional component (powder) whereas; the composition of '441 does not. The composition of '441 is not limited to what is claimed as the language "comprising" is used. One of ordinary skill in the art would be motivated to incorporate a powder into the composition for the purposes of providing texture to the final product i.e. soap, which may be used as a skin exfoliate.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

13. Applicant's arguments filed March 5, 2007 have been fully considered but they are not persuasive.

Applicants argue that the composition of '441 does not teach 10-99% of a powder component. As stated in the office action the claim language is open and not limited to only what is claimed. The addition of a powder to a cosmetic composition is well known in the cosmetic art. When formulating a texturizing composition, the amount of powder added would determine how much texture the composition will have. A large amount of powder produces a composition with a lot of texture, whereas a small amount of powder produces a composition with little texture. Furthermore, in review of the specification applicants teach the use of a powder under the name of Micropearl™ in several examples.

14. The provisional rejection of claims 12-34 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-21, 27-41, 44, 47 and 49 of copending application 10/459,085 is being maintained for the reasons stated in the office action dated September 5, 2007.

15. Claims 12-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-21, 27-41, 44, 47 and 49 of copending Application No. 10/459,082. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed towards a composition comprising a "self-invertible inverse latex" as defined above (see Nature of Invention). The difference between the two lies in that the instant application requires an additional component (powder) whereas; the

composition of '082 does not. The composition of '082 is not limited to what is claimed as the language "comprising" is used. One of ordinary skill in the art would be motivated to incorporate a powder into the composition for the purposes of providing texture to the final product i.e. paint to formulate texturized paint.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

16. Applicant's arguments filed March 5, 2007 have been fully considered but they are not persuasive.

Applicants argue that the composition of '082 does not teach 10-99% of a powder component. As stated in the office action the claim language is open and not limited to only what is claimed. The addition of a powder to a cosmetic composition is well known in the cosmetic art. When formulating a texturizing composition, the amount of powder added would determine how much texture the composition will have. A large amount of powder produces a composition with a lot of texture, whereas a small amount of powder produces a composition with little texture. Furthermore, in review of the specification applicants teach the use of a powder under the name of Micropearl™ in several examples.

17. **The rejection of claims 12-14, 16, 17, 29-35, 39 and 40 under 35 U.S.C. 103(a) over Mikolajewicz et al. is hereby withdrawn in view applicants arguments.**

Allowable Subject Matter

18. Claim 41 is allowed. The prior art does not teach a composition **consisting essentially of** from about 1% to 90% of at least one self-invertible inverse latex and from about 10% to about 99% of at least one powder. The closest prior art reference of Mikolajewicz et al. teaches a composition comprising a self-invertible inverse latex and a powder component; however, the powder was in a concentration of only 5%. A concentration of the powder at 10% was neither taught nor suggested. The composition also contains other components that material affect the composition such as water, a preservative, and a stabilizer.

Conclusion

19. Claims 12-40 remain rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Konata M. George
Patent Examiner
Technology Center 1600


Johann Richter
Supervisory Patent Examiner
Technology Center 1600